



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,114	08/25/1999	JOHN A. ARCADI	35687/RW/H29	6120

7590 03/11/2002

R WILLIAM JOHNSTON
CHRISTIE PARKER & HALE LLP
P O BOX 7068
PASADENA, CA 911097068

EXAMINER

GOLDBERG, JEROME D

ART UNIT	PAPER NUMBER
----------	--------------

1614

DATE MAILED: 03/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/383,114

Applicant(s)

ARCADI, JOHN A.

Examiner

Jerome D Goldberg

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 17-19 and 25-27 is/are allowed.
- 6) ☒ Claim(s) 9-16 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claims 1-8, 17-19, and 25-27 are being allowed in view of the Dr. Jones declaration, Paper No. 12. Dr. Jones states on page 3, paragraph no. 11 that "base on my experience and the skepticism of colleagues with respect to the possible efficacy of rhodamine – 123 for treating prostate cancer, the work published by Dr. Arcadi 1986 and 1990 does not provide a reasonable expectation that rhodamine – 123 would be any more effective combating human prostate cancer than any of many other agents which should promising laboratory results, and failed to be therapeutic ... By any objective standard if Dr. Arcadi in 1986 and 1990 articles had actually created a reasonable expectation that treatment with rhodamine – 123 would prolong the life of prostate cancer victims, the compound would have been put to wide use instead of being dismissed as clinically inadequate by other workers in that fields".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Arcadi references (1986) and (1990) of record.

The Arcadi references teach applicant's compound for treating cancer in a saline solution. The references do not teach applicant's specific carrier. Accordingly, one skilled in this art would find ample motivation from the prior art supra to make pharmaceutical composition of the know anticancer agent with a reasonable expectation that said composition would be effective for treating cancer.

Clearly a showing of the prior pharmaceutical composition is needed.

Claims 20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Bernal et al. reference.

The Bernal et al. reference teaches Rhodamine – 123 “exhibited anticarcinoma activity in mice with various exptl. Carcinomas...” (AB, lines 1 and 2). Therefore, one skilled in this art would find ample motivation from the prior art supra employ the prior art anti-cancer agent to that carcinomas with a reasonable expectation that said anti-cancer agent would be effective to combat said carcinomas.

Claims 20-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No basis is seen in the specification and claims as filed to the terms “carcinoma”.

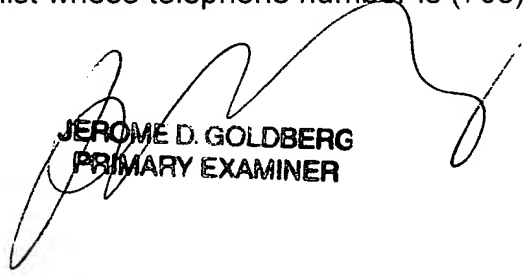
The amendment filed on January 8, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the terms “carcinoma” on page 1, line 10, page 2, line 4, line 25 and line 29 and Title and the term “one of many carcinomas, such as cancer of the breast, hives, pancreas, bladders, lung, skin, colon and the like” on page 1, line 14 lacks clear basis in the specification and claims as filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Goldberg whose telephone number is (703) 308-4606. The examiner can normally be reached on Monday to Thursday from 9 AM to 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne ^{Didel} ~~Curtis~~, can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


JEROME D. GOLDBERG
PRIMARY EXAMINER

Goldberg/LR

February 28, 2002